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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,048	09/22/2003	Shih Huei Liang	LEEL121740	7271
26389	7590	11/01/2005	EXAMINER	
CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC 1420 FIFTH AVENUE SUITE 2800 SEATTLE, WA 98101-2347			STACOVICI, STEFAN	
			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,048

Applicant(s)

LIANG, SHIH HUEI

Examiner

Stefan Staicovici

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-18 and 20-26 is/are pending in the application.
- 4a) Of the above claim(s) 21-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed August 10, 2005 has been entered. Claims 16-18 and 20-26 are pending in the instant application.

Election/Restrictions

2. Newly submitted claims 21-26 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the newly added claims are drawn to an environmentally friendly paper which is a independent invention from the claimed composition and process of original claims 1-19.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-26 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 16-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakurai *et al.* (US Patent No. 4,219,453) in view of Saito *et al.* (US Patent No. 6,156,845).

Sakurai *et al.* ('453) teach the basic composition for forming a "paper-like" film including 35% to 90% by weight ethylene polymer (polyethylene), 10% to 65% by weight inorganic minerals and minor amounts of other additives. Although the claimed proportion of each component of the mixture is not completely included by the taught proportion ranges of Sakurai *et al.* ('453), but only part of the claimed range, it is noted that the amount used is influenced by the size of the particles, the type and grade of olefin resin selected, the molding conditions, the desired film thickness and therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use routine experimentation to determine an optimum resin composition that assures a "paper-like" film having high mechanical strength, formability and water resistance. Further, it should be noted that Sakurai *et al.* ('453) teach "minor" amounts of additives, which can be read upon the claimed 1%-2% by weight of the total mixture.

Regarding claim 16, although Sakurai *et al.* ('453) teach an ethylene based composition and "minor" amounts of additives, Sakurai *et al.* ('453) do not teach a specific additive for said ethylene based composition. Saito *et al.* ('845) teach a variety of additives specifically used to improve the thermal properties, corrosion resistance and weather resistance of ethylene based polymers including, N,N-bis(2-hydroxyethyl)stearyl amine (see col. 24, lines 10-23 and col. 26, lines 30-35). Therefore, it would have been obvious for one of ordinary skill in the art to have provided N,N-bis(2-hydroxyethyl)stearyl amine as taught by Saito *et al.* ('845) as an additive in the composition of Sakurai *et al.* ('453) because, Saito *et al.* ('845) specifically teach that N,N-

bis(2-hydroxyethyl)stearyl amine provides for improved thermal properties, corrosion resistance and weather resistance of an ethylene based composition, whereas Sakurai *et al.* ('453) suggests "minor" amounts of additives for a ethylene based composition, hence requiring the teachings of Saito *et al.* ('845) to function as described.

In regard to claim 17, Sakurai *et al.* ('453) teach the use of titanium oxide, zinc oxide, calcium sulfate, barium sulfate, clay (col. 2, lines 61-68).

Regarding claim 18, Sakurai *et al.* ('453) teach the use of high density polyethylene (col. 4, line 55).

Specifically regarding claim 20, Sakurai *et al.* ('453) teach that the composition for forming a "paper-like" film is in pellet (granule) form (see col. 6, lines 50-65).

Response to Arguments

5. Applicant's remarks filed August 10, 2005 have been considered.

6. Applicants argue that "the claimed invention does not include either the higher fatty acid or a metal salt of a higher fatty acid" (see page 6 of the amendment filed 8/10/2005). In response, it is noted that under MPEP §2111.03, "[T]he transitional term 'comprising'...is inclusive or open-ended and does not exclude additional, unrecited elements or method steps." *See, e.g., Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003).

7. Applicants argue "that the cited reference does not describe, teach or suggest the specified additives in amended Claim 16" (see page 7 of the amendment filed 8/10/2005).

However, this argument is drawn to a newly presented claim limitation not previously presented that has been rejected in this Office Action as set forth above.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Staicovici, Ph.D. whose telephone number is (571) 272-1208. The examiner can normally be reached on Monday-Friday 9:30 AM to 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Colaianni, can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stefan Staicovici, PhD



Primary Examiner

10/28/05

AU 1732

October 28, 2005